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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,707	07/03/2001	Thomas Zickell	NEI-010XX	2439
7590	05/18/2005		EXAMINER	
Bourque & Associates, P.A. Suite 303 835 Hanover Street Manchester, NH 03104			AUGHENBAUGH, WALTER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/898,707	ZICKELL, THOMAS	
	Examiner Walter B. Aughenbaugh	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 January 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 11-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. The amendments made in claims 1 and 13-15 in the Amendment filed on January 28, 2005 (Amdt. D) have been received and considered by Examiner.

### ***WITHDRAWN OBJECTIONS***

2. The objection to claims 13 and 15 made of record in paragraph 10 of the previous Office Action mailed July 29, 2004 has been withdrawn due to Applicant's amendments in claims 13 and 15 in Amdt. D.

### ***REPEATED REJECTIONS***

#### ***Claim Rejections - 35 USC § 112***

3. The 35 U.S.C. 112 rejection of claims 2 and 14 that was repeated in paragraph 9 of the previous Office Action mailed July 29, 2004 has been repeated for the reasons previously made of record. In regard to claim 2, the Office maintains the rejection of claim 2 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections.

See MPEP § 2172.01. The omitted structural cooperative relationships are: the structural relationship between the parting agent covered surface area, the substrate and the clean surface area; the phrase "generally opposite" does not definitely recite the structural relationship between the parting agent covered surface area, the substrate and the clean surface area. Applicant traverses this rejection on page 10 of Amdt. D by stating that "[t]he term "generally" does not render a claim indefinite *per se*", but claim 2 is not rejected under 35 U.S.C. 112, second paragraph merely because the term "generally" is in the claim: claim 2 is rejected because the

structural relationship between the parting agent covered surface area, the substrate and the clean surface area is not definitely recited. Applicant does not explain how the instant language of claim 2 definitely recites the structural relationship between the parting agent covered surface area, the substrate and the clean surface area on pages 10-11 of Amdt. D. The rejection of claim 14 under 35 U.S.C. 112 is repeated only for the lack of antecedent basis of the "said granular materials" recitation. Claim 14 recites "a granular material" in singular form in the 11<sup>th</sup> line of the claim.

***Claim Rejections - 35 USC § 103***

4. The 35 U.S.C. 103 rejection of claims 1-9 and 11-15 made of record in paragraph 11 of the previous Office Action mailed July 29, 2004 has been repeated for the reasons previously made of record, and for the following reason that addresses the amendment made in claims 1 and 14 in Amdt. D: the recitation "said lower surface adapted to disposed proximate said support surface when covering said support surface" does not positively recite any structural limitations due to (1) the indefiniteness of the term "proximate", see 35 U.S.C. 112 rejection of claims 1 and 14 made of record in this Office Action, (2) the fact that the recitation "when covering said support surface" is an optional limitation (therefore, not a positive limitation) that does not require that the lower surface covers the support surface and (3) it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138.

***NEW REJECTIONS***

***Claim Rejections - 35 USC § 112***

5. Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation “said lower surface adapted to disposed proximate said support surface” renders the claims 1 and 14 indefinite because the structure intended to be recited by the term “proximate” cannot be ascertained; therefore, the structural relationship between the lower surface and the support surface cannot be ascertained. Furthermore, that which is intended to be recited by the phrase “adapted to disposed” cannot be ascertained.

***Response to Arguments***

6. Applicant’s arguments presented on pages 11-15 of Amdt. D in regard to the 35 U.S.C. 103 rejection of claims 1-9 and 11-15 have been fully considered but are not persuasive. Applicant argues that the edge portion 13 of McGroarty “is not disposed on the top surface [of McGroarty]” and therefore, that there is no motivation to rely upon McGroarty to modify the material of Kennepohl, but, in response to Applicant’s arguments presented on most of pages 12 and 13 of Amdt. D, since McGroarty teach that the “lap” structure of one sheet “lapping” another sheet over the clean surface area of the another sheet is a well known structure in the art of roof waterproofing, one of ordinary skill in the art would have recognized to have set the particular orientation of the edge portion 13 depending on the particular desired end result.

Applicant argues in the paragraph bridging pages 13 and 14 through page 15 of Amdt. D that “modifying McGroarty” would render the invention of McGroarty unsuitable for its intended

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purpose, but McGroarty is not the reference being modified in the 35 U.S.C. 103 rejection of claims 1-9 and 11-15: McGroarty is not the primary reference in the current rejection of record.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

05/13/05 WBA

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1992

5/16/05